



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,398	12/15/2003	Henry C. Hight JR.	P-123057.1 (UTI)	6209

7590 07/30/2004

Daniel D. Chapman, Esq.  
JACKSON WALKER L.L.P.  
Suite 2100  
112 E. Pecan Street  
San Antonio, TX 78205

EXAMINER

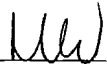
PATEL, VISHAL A

ART UNIT	PAPER NUMBER
----------	--------------

3676

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/736,398	Applicant(s) HIGHT ET AL.	
	Examiner Vishal Patel	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>7/26/03</u> |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                 |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/2/04</u> | 6) <input type="checkbox"/> Other: ____   |

### DETAILED ACTION

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: figures 1-2, 3-8 and 10-11, figures 3-8 and 10-11 describe other aspects of the invention in figures 1-2.

Species II: figures 9-9b.      Species III: fig. 9c.      Species IV: fig. 12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Daniel Chapman on 7/23/04 a provisional election was made without traverse to prosecute the invention of species I, claims 1-10 and 12-20.

Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

1. Claim 1 objected to because of the following informalities: claim 1, line 8, "at R", unclear what applicant is meaning by R. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Penna et al (US. 3,160,251).

Art Unit: 3676

Regarding claim 1: Penna discloses a clip (10) comprising a head (12) having an apex (apex of 12), a pair of shoulders (shoulders of 12) and a neck (neck 24) and having a longitudinal axis (longitudinal axis of head 12). A base (portion of 10 after the neck 24) attached to the head, the base comprising at least one coil coarse (the coil having an apex 14), the coil coarse having a radius of curvature R (radius of curvature of the coil), the radius of coil (radius after the neck 24) at an origin of the longitudinal axis of the head, the coil coarse having a plane (the coil having the apex 14 lies in a plane) and the longitudinal axis of the head perpendicular to the coil coarse and intersecting the coil coarse.

Regarding claim 2: The head, apex, shoulders, neck and the at least one coil coarse are formed from a single resilient wire (the clip is made of single resilient wire).

Regarding claim 3: The base including at least two coarses (second coil coarse having 20) and the coarse furthest removed from the head includes a tail (tail 16).

Regarding claim 4: The base includes a tail (tail 16).

Regarding claim 5: The single resilient wire has first and second ends (first end which is contained by 12 and second end near 16).

Regarding claim 6: The head includes the apex, the neck and the pair of shoulders between the apex and the neck (the head 12 includes the apex, the neck and the pair of shoulders between the apex and the neck).

Regarding claim 7: The base includes a tail portion (portion of 16 which forms base).

Regarding claim 8: The head is defined by a single plane (the head 12 which lines in a single longitudinal plane).

Regarding claim 9: The base includes multiple coils (coil having 14 and second coil having 20).

Art Unit: 3676

4. Claims 5 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolduc et al (US. 6,296,656 B1).

K,VP  
Regarding claims 5 and ~~10~~<sup>9-10</sup>: Bolduc discloses a clip comprising a single strand of resilient wire (wire of clip in figure 11), the strand having a first end and a second end (first end on left side of figure and the second end having a pointy end). A portion of the single strand defining a head (the first end having a head) having a longitudinal axis, the head including the first end of the wire, a portion of the single strand defining a base (base including the pointy end), the base having at least one coil (coil before the pointy end), the base including multiple of coils (multiple coils before the pointy end) and the multiple coils having same radius of curvature R (the multiple coils have the same radius of curvature as showed in figure 11).

5. Claims 12-20 is rejected under 35 U.S.C. 102(b) as being anticipated by Bono jr. et al (US. 6,533,289 B2).

Regarding claim 12: A sealing apparatus comprising a gasket (gasket having 12 and 16), a clip (clip of figure 6) engaged with the gasket (the clip engages the gasket), the clip having a head (head 126) and a coiled base (coiled base 124 having ends 122a and 122b), the coil base with a constant radius of curvature (coils having ends 122a and 122b have same radius of curvature).

Regarding claim 13: The gasket includes a woven sheath and a woven wire core (core 12 which is woven and a woven sheath 16).

Regarding claim 14: The clip base is comprised of wire, the wire dimensioned for insertion between weaves of the sheath and the wire core (clip of figure 6 inserted in the gasket, similar to as seen in figures 2-3).

Art Unit: 3676

Regarding claim 15: The woven wire core defines an interior space inside of the gasket and wherein the base is disposed substantially within the interior space when the clip is engaged with the gasket (the base is disposed in an interior spaced inside of the gasket, clip of figure 6 inserted in the gasket, similar to as see figure 2).

Regarding claim 16: The head is disposed substantially outside of the woven sheath of the gasket (when clip of figure 6 is inserted in the sheath, similar to as seen in figures 1-3).

Regarding claim 17: The head of the clip defines an apex (apex on top of shoulders 126a and 126b), shoulders (126a and 126b) and a neck (neck near C). The neck lays adjacent weaves of the sheath and the wire core when the clip is engaged with the gasket (when the neck is inserted in the gasket, similar to as seen in figures 1-3).

Regarding claim 18: The base of the clip lies in a first plane (plane of 124) and the head of the clip lies in a second plane (plane of 126). The planes being substantially perpendicular (the planes are perpendicular).

Regarding claim 19: The base includes a multiplicity of coarses (coarse having 122b and coarse having 122a).

Regarding claim 20: The base includes a tail (tail 122b).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is (703) 308-8495. The examiner can normally be reached on Monday through Friday from 7:30 PM to 4:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann, can be reached on (703) 306-4115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168. Technology Center 3600 Customer Service is available at 703-308-1113. General Customer

Art Unit: 3676

Service numbers are at 800-786-9199 or 703-308-9000. Fax Customer Service is available at 703-872-9325.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:** 703-872-9326, for formal communications for entry before Final action: or,  
703-872-9327, for formal communications for entry after Final action.

Hand-delivered responses should be brought to Crystal Park Five, 2451 Crystal Drive, Arlington, Virginia, Seventh Floor (Receptionist suite adjacent to the elevator lobby).

VP  
July 26, 2004

A handwritten signature in black ink, appearing to read "Vishal Patel". The signature is fluid and cursive, with the first name "Vishal" and last name "Patel" clearly distinguishable.

Vishal Patel  
Patent Examiner  
Tech. Center 3600